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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,482	04/25/2001	Gary B. Gordon	10980523-1	9824

7590

06/12/2003

IP Administration  
Legal Department, 20BN  
HEWLETT-PACKARD COMPANY  
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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 06/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Advisory Action

Application No.  
**09/842,482**

Applicant(s)  
**Gordon et al**

Examiner  
**Maurie G. Baker, Ph.D.**

Art Unit  
**1639**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED May 16, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s):  
The proposed amendment would overcome the rejection under 35 USC 112, second paragraph, if entered in further prosecution.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
Please see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 33-35
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

MAURIE G. BAKER, PH.D.  
PRIMARY EXAMINER  
ART UNIT 1639

## ADVISORY ACTION

### *Attachment*

1. Applicant's After Final amendment filed May 16, 2003 does not place the case in condition for allowance and the rejections are maintained for reasons of record and the further reasons set forth below.

2. It is noted for the record that the proposed claim amendment would overcome the rejection under 35 USC 112, second paragraph, if entered in further prosecution.

However, applicant's arguments regarding the rejection under 35 U.S.C. 102(b) over Cozzette et al were not found persuasive. This is discussed more fully below.

3. Applicant argues that Cozzette et al does not disclose a "matrix of electronically addressable sites" where "matrix" is defined as "rectangular arrangement of elements into rows and columns". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "matrix" defined as "rectangular arrangement of elements into rows and columns") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Moreover, there does not appear to be anything in the instant specification that would indicate that the claimed "matrix of electronically addressable sites" was limited to

the situation as argued by applicant (i.e. “matrix” is not limited to “rectangular arrangement of elements into rows and columns”). In fact, there is no such definition of “matrix” in the instant specification. Applicant points to page 4 of the specification (lines 17-18) for other limitations on the claimed “matrix”; however, the claims are not limited to the specifics set forth in this portion of the specification either.

5. Thus, as stated in the Final Rejection, the different areas and layers of the sensors of Cozette are deemed to read on the claimed “matrix of electronically addressable sites” see, for example, Figure 1 of the patent. Also, as an embodiment of the sensors of Cozzette et al uses “oligonucleotides, polynucleotides, molecules of DNA, molecules of RNA, active fragments or subunits or single strands...”, the prior art structure is capable of performing the intended use and meets the limitations of the claims (see *In re Casey*, and *In re Otto*, cited in the previous action).


6. With respect to the argument that Cozzette et al indicates that dicing the wafer is a drastic step, this is irrelevant to the rejection. The reference clearly discloses “dicing the wafer to yield individual glucose sensors” for the particular embodiments of the patented invention (see Section 5.1.5, beginning in column 40, line 56). As the particular embodiments of Cozzette’s invention are deemed to read on the claimed invention, the prior art meets the limitations of the claims.

7. For these reasons and the reasons of record, the rejection of claims 33-35 under 35 U.S.C. 102(b) as being anticipated by Cozzette et al is maintained.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.  
June 6, 2003



MAURIE GARCIA BAKER PH.D  
PRIMARY EXAMINER